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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/621,629
Filing Date: July 17, 2003
Appellant(s): O'BRIEN ET AL.

Glenn E. Forbis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/11/2006 appealing from the Office action mailed 9/12/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,488,206	Mizusawa	12-1984

Appellant's admitted prior art: figures 1 and 2 presented in the current application 10/621,629

(9) Grounds of Rejection

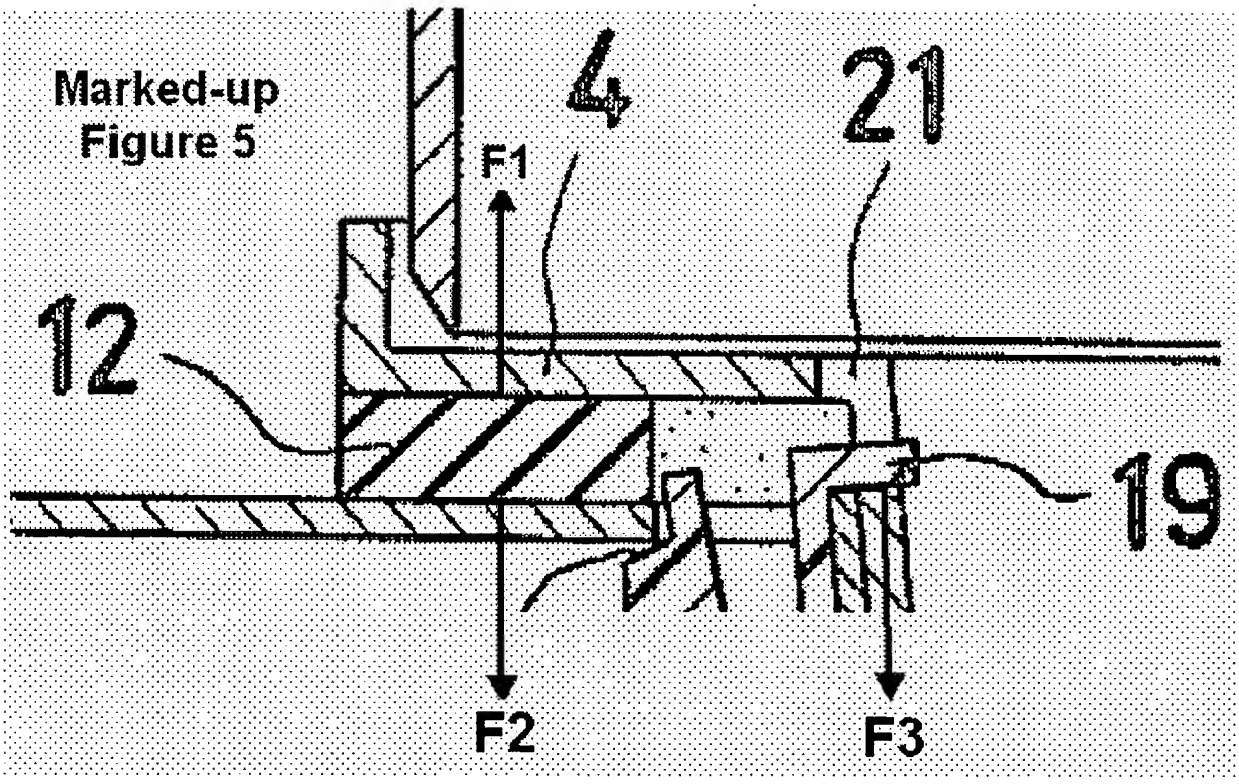
The following ground(s) of rejection are applicable to the appealed claims:

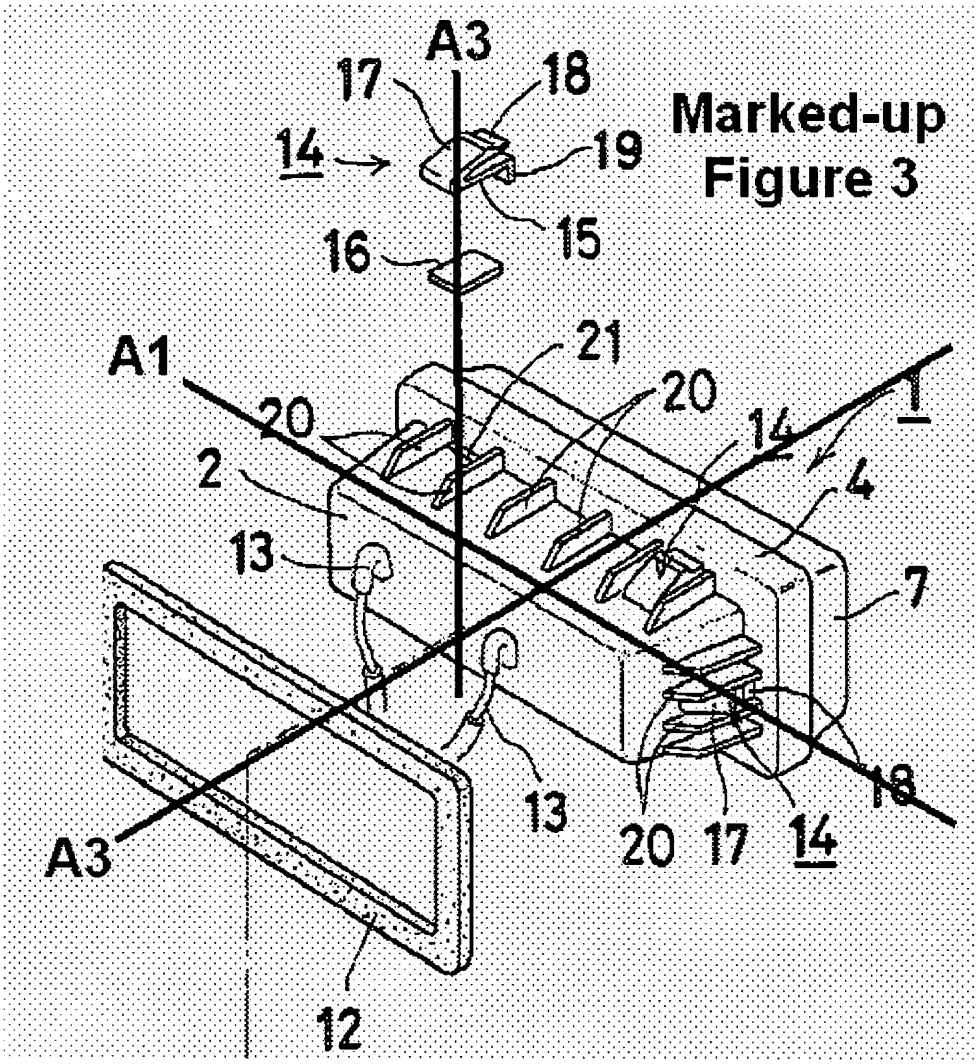
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-12, 17-21 and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizusawa (U.S. Patent 4,488,206) (see marked-up figures below).





Claim 1. Mizusawa discloses (figs.3) a plug (1) inserted into and enclosing an opening (6) within a wall (wall of 5) of a hollow post (5) and securing a wire harness (13) running within the hollow post, comprising: at least two locks (left side 14, right side 14) projecting out from a surface of the plug and securing the plug within the opening, at least one of the locks (right 14) being located at or near a first end (right end of 1) of the plug, and at least one of the locks (left 14) being located at or near a second end (left end of 1) of the plug within the opening along a first axis (axis A1 connecting left 14 and right 14); at least two tensioners (top left 14; bottom left 14) projecting out from the surface of the plug and resiliently engaging the edge of the

opening and aligning the plug within the opening along a second axis (axis A2 connecting top left 14 and bottom left 14), at least one of the tensioners (top left 14) being located at or near a first edge (top edge of 1) of the plug, and at least one of the resilient tensioners (bottom left 14) being located at or near a second edge (bottom edge of 1) of the plug; at least one stabilizer (12) projecting out from the surface of the plug and resiliently engaging the wall, thereby exerting tension within the plug along a third axis (axis A3 between 1 and 5); and at least one fastener (2 and ends of 13) for securing the wire harness to the plug. Note marked-up figure 5 above which shows that the compression of stabilizer (12) inherently results in a equal and opposite reactionary force (F1, F2) as a basic fact of statics. The upward component (F1) of which presses upward against section (4) of plug (1). Section (4) of plug (1) resists upward movement (remains static) due to the downward force (F3) applied on section (4) of plug (1) by element (9). The oppositely directed forces (F1, F3) inherently create a tension in section (4) of plug (1) therebetween (which is most highly concentrated in the inner corner of area 21). Because section (4) is a component of Plug (1) the tension is created within the plug along the third axis which runs therethrough.

Claim 2. Mizusawa discloses that the first and second axes are approximately perpendicular to one another (side to side and top to bottom).

Claim 3. Mizusawa discloses that the third axis (running between 5 and 1 in and out) is perpendicular to said first and second axes.

Claim 4. Mizusawa discloses that the first and second ends of the plug lie opposite to one another, and the first and second edges of the plug lie opposite to one another.

Claim 5. Mizusawa discloses that the hollow post is a pillar of an automobile.

Claim 7. Mizusawa discloses that at least one stabilizer comprises a pair of resilient protrusions extending out from the surface of the plug.

Claim 8. Mizusawa discloses at least two stabilizers (top wall of 12, bottom wall of 12), with at least one of the stabilizers located near the first edge of the plug, and at least one of the stabilizers located near the second edge of the plug.

Claim 9. Mizusawa discloses that the fastener comprises at least one clip (clips at top of 13 as seen in fig.3) that projects out from the surface of the plug and secures the wire harness.

Claim 10. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the plug.

Claim 11. Mizusawa discloses that each of the at least two locks initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of left side 14 and right side 14) that promotes alignment of the plug respective to the opening.

Claim 12. Mizusawa discloses that each of the at least two tensioners initially engages the edge of the opening with a generally rounded end portion (generally rounded end portions of top left 14 and bottom left 14) that promotes alignment of the plug respective to the opening.

Claim 17. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two tensioners (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two tensioners each having a portion (18 on top left 14; and 18 on bottom left 14); at least two stabilizers (top wall of 12 and bottom wall of 12) projecting

out from the body of the pillar shield and at least one fastener (2 and ends of 13). Additionally, Mizusawa further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The stabilizers (top wall of 12 and bottom wall of 12) are arranged to be resiliently compressed by a wall of a pillar thereby directing a force along a third axis tending to push a shield away from a wall (in that they are arranged on one side of a shield 1 such that a wall of a pillar could compress the stabilizers from behind thereby directing a force along a third axis tending to push the shield away from a wall).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).
- The tensioners' portions (18 on top left 14; and 18 on bottom left 14) are fully capable of performing use as for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 18. The appellant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim 19. The appellant does not positively recite, but rather only functionally recites, a first, second and third axis such that the Mizusawa assembly is similarly capable of function along a third axis that lies perpendicular to the first and second axis.

Claim 20. Mizusawa discloses that at least one of the clips is located at an end (left end of 1) of the pillar shield, and at least one of the clips is located at an opposite end (right end of 1) of the pillar shield.

Claim 21. Mizusawa discloses that at least one of the tensioners is located nearby an edge (top edge of 1) of the pillar shield, and at least one of the tensioners is located nearby an opposite edge (bottom edge of 1) of the pillar shield.

Claim 23. Mizusawa discloses that the fastener comprises at least one clip (portion of 13, as seen in fig.9, clipping onto the two left portions of 13) projecting out from the body of the pillar shield and securing the wire harness.

Claim 24. Mizusawa discloses that the fastener comprises a tie (tie portion of 13, as seen in fig.9, as wrapping around two left portions of 13 and attaches to 1) that wraps around the wire harness and then attaches to the pillar shield.

Claim 25. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two stabilizers (top wall of 12 and bottom wall of 12) projecting out from the body of the pillar shield and at least one fastener (2 and ends of 13). Additionally, Mizusawa further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).

- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The stabilizers (top wall of 12 and bottom wall of 12) are arranged to be resiliently compressed by a wall of a pillar thereby directing a force along a third axis tending to push a shield away from a wall (in that they are arranged on one side of a shield 1 such that a wall of a pillar could compress the stabilizers from behind thereby directing a force along a third axis tending to push the shield away from a wall).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).

- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 26. The appellant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim 27. Mizusawa discloses (fig.3) a pillar shield, comprising: a generally planar-shaped body (1); at least two clips (left side 14 and right side 14) projecting out from the body of the pillar shield each of the at least two clips having resilient locks (18 on left side 14; and 18 on right side 14); at least two tensioners (top left 14 and bottom left 14) projecting out from the body of the pillar shield, the at least two tensioners each having a portion (18 on top left 14; and 18 on bottom left 14); and at least one fastener (2 and ends of 13). Additionally, Mizusawa further discloses the claimed functional limitations since it is fully capable of such function as follows:

- The planar shaped body (1) is designed to close off an opening within a wall of a pillar (in that it is designed to have square solid structure fully capable of filling a square opening within a wall of a pillar).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for securing the pillar shield within an opening in a wall (in that they are configured with a tapered shape capable of such securing via contact with an edge of an opening in a wall).
- The resilient locks (18 on left side 14; and 18 on right side 14) are configured for being compressed by an edge of an opening to align a pillar shield within an opening

along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).

Finally, Mizusawa meets the following intended use limitation since it is fully capable of such usage as follows:

- The pillar shield is fully capable of being for securing a wire harness running within a pillar including a wall having an opening with an edge since it presents structure capable securing a wire harness (via, fasteners, tape, glue, etc.) within a pillar including a wall having an opening with an edge (i.e. an edge shaped complementary to the shield).
- The tensioners' portions (18 on top left 14; and 18 on bottom left 14) are fully capable of performing use as for being compressed by an edge of an opening to align a pillar shield within an opening along a first axis (in that they are configured as being attached to a leaf spring 17 which is attached to the pillar shield and fully capable of allowing and edge of an opening to compress the locks to align the pillar shield within the opening along a first axis).
- The fastener is fully capable of being for attaching a wire harness (i.e., two wires connected to 13) to the pillar shield as shown in fig.3.

Claim 28. The appellant does not positively recite, but rather only functionally recites, a first and second axis such that the Mizusawa assembly is similarly capable of function along a first axis that lies approximately ninety degrees from a second axis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizusawa (U.S. Patent 4,488,206) in view of the Appellant's admitted prior art (Figures 1 and 2).

Claims 6 and 22. Mizusawa does not disclose that the plug/pillar shield is a one-piece monolithic structure. The Appellant's admitted prior art (figs. 1 and 2) illustrates that one-piece monolithic structure plugs/pillar shields (200) are old and well known in the art. One of ordinary skill in the art would easily recognize that one-piece monolithic construction reduces the number of parts to be assembled and thus inherently simplifies assembly. Furthermore, the appellant's plug/pillar shield would appear to operate similarly regardless of whether or not one-piece or multi-piece construction is used such that the one-piece limitation is not critical to the appellant's invention but rather amounts to mere design choice. It has generally been recognized that one-piece construction, in place of separate elements fastened together, is a design consideration within the skill of the art. In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968); In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965). Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Mizusawa plug/pillar shield to be of one-piece monolithic structure for the benefit of simplifying assembly, and further since such practice is

old and well known in the art (as demonstrated by the appellant's admitted prior art) and still further since it is a non-critical design consideration within the skill of the art.

(10) Response to Argument

The appellant argues that the Mizusawa stabilizer (12) does not exert or generate tension along a third axis since the Mizusawa stabilizer only generates "moderate pressure" as recited in Mizusawa, col.6, ll.1-3). This is not persuasive. The claims do not recite any specific degree of tension. Such that moderate tension in parts caused by moderate pressure read on the appellant's claims just as much as a great pressure and tension would. Furthermore, note marked-up figure 5 in the rejections above which shows how the compression of stabilizer (12) inherently results in a equal and opposite reactionary force (F1, F2) as a basic fact of statics. The upward component (F1) of which clearly presses upward against section (4) of plug (1). Section (4) of plug (1) clearly resists upward movement (remains static) due to the downward force (F3) applied on section (4) of plug (1) by element (9). The oppositely directed forces (F1, F3) inherently create a tension in section (4) of plug (1) therebetween (which is most highly concentrated in the inner corner of area 21). Because section (4) is a component of Plug (1) the tension is created within the plug along the third axis which runs therethrough.

The appellant argues that Muzusawa body is not "generally planar shaped" since it comprises non-planar aspects including box shapes. This is not persuasive since the limitation the claims have a scope that does not require a perfectly planar shape but rater a "generally planar" shape that may or may not have various non-planar attributes in addition to its planar attributes. The Muzusawa body presents many planar surfaces such that it is "generally planar

shaped" in as much as the appellant's own invention is generally planer (rather than perfectly planer). Note that the appellant's own invention is not perfectly planar but rather has numerous non-planar projections and a box-shaped portion near 720. Appellant has failed to show how the appellants own box shape is any more planer than the prior art box shape and further failed to point out any specific limitation forbidding any specific degree of box dimension (depth, width, etc.)

The appellant argues that there is no motivation to combine Muzusawa and the appellant's admitted prior art. This is not persuasive. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the **knowledge generally available to one of ordinary skill in the art** (emphasis added). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation comes from inherent fact readily identifiable and available to one of ordinary skill in the art as a matter of common sense (i.e. recognition that one-piece monolithic construction inherently reduces the number of parts to be assembled and thus inherently simplifies assembly over multi piece construction).

The appellant argues that Mizusawa is not bodily incorporable with the appellant's admitted prior art since elements 14 of Mizusawa cannot be made unitary with element 1 of Mizusawa without also making the entirety of the Mizusawa disclosure a single unitary lump, lights and all which would not permit the purpose of assembly of Mizusawa. This is not persuasive. The test for obviousness is not whether the features of a secondary reference may be

bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). However, though not necessary for a proper obviousness rejection, the examiner notes that making elements 14 unitarily homogenous with, rather than removable from, element 1 of Mizusawa, would not detract from the installation purpose of the assembly into element 5, since elements 14 are attached to element 1 prior to insertion into element 5 anyway. In fact homogenous construction can only simplify assembly by omitting the need for the step of attaching 14 to 1. If the appellant means to imply that one of ordinary skill in the art could not conceive of combining Mizusawa with the admitted prior art without destroying the light supporting function of Mizusawa (i.e. making the light bulb, wires, and car all one piece such that they have no moving parts and cannot function as commonly known) then the examiner reminds the appellant that in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985). Furthermore, the appellant's admitted prior art clearly shows that it is desirable to make unitary a clip 200 with its fasteners (210, 240, 230, 250, 220) and not the entirety of the elements intended to be supported by the clip. Accordingly, it is inconceivable that a person of ordinary skill in the art would have failed to appreciate that elements 14 could be made homogenous with element 1 without the destroying the function of the car and lights of Mizusawa. Such an argument by the appellant would require an improper assumption that the artisan possesses less than ordinary skill.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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